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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,920	10/19/2001	Naoto Kinjo	1110-0297P	6316
2292 7590 09/21/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER MONFELDT, SARAH M	
			ART UNIT 3692	PAPER NUMBER
			NOTIFICATION DATE 09/21/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 09/981,920	Applicant(s) KINJO, NAOTO	
	Examiner Sarah M. Monfeldt	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the Amendment/Response filed on 6 August 2007.
2. Claims 1-13 are currently pending and have been examined.

Response to Arguments

3. Applicant's arguments filed 6 August 2007 with respect to claims 1-3, 5-8, 10, 12-13 have been fully considered but they are not persuasive.
4. Applicant's arguments with respect to Claims 4, 9, 11 have been fully considered and are persuasive. The rejection of claim 11 as being unpatentable over Graef in view of Lynch has been withdrawn. However, it is respectfully pointed out that Claims 4, 9 and 11 recite limitations similar to those recited in claims 12 and 14, which were rejected as being anticipated by Drescher in the previous Office Action. Therefore, claim 11 is rejected as being unpatentable over Graef in view of Lynch and Drescher as presented below.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 12 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Drescher et al (hereinafter Drescher US PAT 6,131,809).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Re Claim 12: Drescher discloses a media module for use in a self-service terminal, the media module comprising:

- Means defining a media dispense path (See at least Fig 1, and Column 27 line 21-Column 29, line 59)
- A plurality of media containers (see at least Fig 1, Refs 100, 102, 104 and 106: Column 11, lines 41-52)
- A friction pick mechanism associated with each media container within the media module for picking media from the media container (see at least Column 11, lines 53-65; Column 28, lines 1-22) and transferring the picked media to the media dispense path (see at least Column 29, lines 10-20) for transporting media from the media dispensing module (see at least Column 29, lines 15-20)

Re Claim 14: Drescher discloses a method of dispensing media from a self-service terminal, the method comprising the steps of:

- Selectively removing media from one of a plurality of media containers disposed within a media module, wherein each of the media containers within the media module includes a friction pick mechanism for picking media from the media container and transferring the picked media to a media dispense path for removing the media from the media module (See at least Fig 1, and Column 27 line 21-Column 29, line 59)
- Presenting removed media to a user (see at least Column 30, lines 35-40)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3,6-8, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graef in view of Lynch et al (hereinafter Lynch, US 6,029,971).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures

Art Unit: 3692

may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Re Claim 1: Graef discloses a self-service terminal comprising:

- A plurality of media modules (see at least Fig 1, 44, 46, 48, 50; Column 7, lines 42-52)), each module operatively associated with a pick mechanism for picking media from the module (see at least Fig 1, 34, 36, 38, 40; Column 7, lines 26-41) and transferring the picked media to a media dispense path (see at least Column 7, lines 53-62), wherein at least one of the modules being associated with a friction pick mechanism (See at least Fig 2 and description Column 8 line 39-Column 10 line 50; cites friction portions of picking mechanism)

In addition, Graef notes that ATMs can be used to dispense a variety of different medias including cash, tickets, scrip, vouchers or other documents (see at least Column 1, lines 18-35). Furthermore, Graef discloses that the modules may hold a variety of different types of documents in the same machine (see at least Column 7, lines 46-48).

Graef does not explicitly disclose at least one module being associated with a vacuum pick mechanism. Lynch discloses that sheet feeding apparatus, such as the one disclosed by Graef "are commonly of either the vacuum pick or friction pick type," and depending on the type of media involved cites the advantages and disadvantages for each (see at least Column 1, lines 5-20). Some media as Lynch points out is better served with a friction mechanism (medias that need a high feed rate), while other media would be better served with a vacuum mechanism (high porous). Thus, it would have been obvious to anyone of ordinary skill at the time of invention to include the teachings of Lynch to the disclosure of Graef so that an ATM containing multiple media types, can distribute the different types of media in the most efficient and practical way possible.

Re Claim 2: Graef in view of Lynch discloses the claimed terminal and Lynch further discloses wherein the modules are removable (see at least Column 2, lines 59-62). While not explicitly disclosing wherein the modules are also interchangeable, this step is notoriously well known in the art and would

Art Unit: 3692

have been obvious to one of ordinary skill, so that when a particular module is removed for service or for transport, it can be replaced with an interchangeable part and the machine can continue to function.

Re Claim 3: Graef in view of Lynch discloses the claimed terminal and Graef further discloses wherein the at least one other module associated with the friction pick mechanism is a friction pick module and the friction pick mechanism is contained within the friction-picking module (See at least Fig 1, Column 7, lines 34-35).

Re Claim 6: Graef discloses a self-service terminal comprising:

- Means defining a media dispense path (see at least Fig 1, See arrows related to Refs 54, 56, 60 and 62)
- A friction pick mechanism (See at least Fig 1 Refs 34, 36, 38 and 40; See Fig 2 and description Column 8 line 39-Column 10 line 50; cites friction portions of picking mechanism)
- A plurality of media modules (see at least Fig 1, 44, 46, 48, 50; Column 7, lines 42-52), each media module operatively associated with a pick mechanism for picking media from the module (see at least Fig 1, 34, 36, 38, 40; Column 7, lines 26-41) and transferring picked media to the media dispense path (see at least Column 7, lines 53-62), wherein at least one of the modules being associated with a friction pick mechanism (See at least Fig 2 and description Column 8 line 39-Column 10 line 50; cites friction portions of picking mechanism)

In addition, Graef notes that ATMs can be used to dispense a variety of different medias including cash, tickets, scrip, vouchers or other documents (see at least Column 1, lines 18-35). Furthermore, Graef discloses that the modules may hold a variety of different types of documents in the same machine (see at least Column 7, lines 46-48).

Graef does not explicitly disclose at least one module being associated with a vacuum pick mechanism. Lynch discloses that sheet feeding apparatus, such as the one disclosed by Graef "are commonly of either the vacuum pick or friction pick type," and depending on the type of media involved cites the advantages and disadvantages for each (see at least Column 1, lines 5-20). Some media as

Art Unit: 3692

Lynch points out is better served with a friction mechanism (medias that need a high feed rate), while other media would be better served with a vacuum mechanism (high porous). Thus, it would have been obvious to anyone of ordinary skill at the time of invention to include the teachings of Lynch to the disclosure of Graef so that an ATM can distribute different types of media in the most efficient and practical way possible.

Re Claim 7: Graef in view of Lynch discloses the claimed terminal and Lynch further discloses wherein the media modules are removable (see at least Column 2, lines 59-62). While not explicitly disclosing wherein the modules are also interchangeable, this step is notoriously well known in the art and would have been obvious to one of ordinary skill, so that when a particular module is removed for service or for transport, it can be replaced with an interchangeable part and the machine can continue to function.

Re Claim 8: Graef in view of Lynch discloses the claimed terminal and Graef further discloses wherein the friction picking mechanism is contained within the media module associated with the friction-picking module (see at least Fig 1, Column 7, lines 34-35).

Re Claim 13: Graef discloses the claimed media-dispensing module but does not explicitly disclose means for enabling the media module to be removed and interchangeable. Lynch discloses a self service terminal wherein the modules are removable (see at least Column 2, lines 59-62). It would have been obvious to anyone of ordinary skill in the art at the time of invention to include the teachings of Lynch to the disclosure of Graef so that said modules can be taken from the machine to either be refilled or taken to a remote location for deposit or reconciliation with records related to transactions at the machine.

While the references do not explicitly disclose wherein the modules are also interchangeable, this step is notoriously well known in the art and would have been obvious to one of ordinary skill, so that when a particular module is removed for service or for transport, it can be replaced with an interchangeable part and the machine can continue to function.

Art Unit: 3692

9. Claim 4-5 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graef in view of Lynch et al (hereinafter Lynch, US 6,029,971) and Drescher (US 6,131,809).

Re Claim 4: Graef in view of Lynch discloses the claimed terminal and Drescher further discloses wherein the friction pick module comprises a plurality of friction pick units, each unit including a media container and a friction pick mechanism (see at least Fig. 58; Column 28, lines 1-22). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the terminal of Graef in view of Lynch to include separate containers with associated friction pick mechanisms as taught by Drescher. One of ordinary skill in the art at the time of the invention would have been motivated to expand the terminal of Graef in view of Lynch in this way since since removable canisters allows for easier removal by authorized personnel (see at least col. 11, ll. 40-46 of Drescher).

Re Claim 5: Graef in view of Lynch discloses the claimed terminal and Graef further discloses wherein the friction pick units share a common media exit path within the module and leading to the media dispense path (See at least Fig 1, process 54 across common path 56 to secondary transport 60; Column 7 lines 53-67).

Re Claim 9: Graef in view of Lynch discloses the claimed terminal and Drescher further teaches wherein the media module associated with friction pick mechanism comprises a plurality of friction pick units, each unit including a media container and a friction pick mechanism (see at least Fig. 58; Column 28, lines 1-22). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the terminal of Graef in view of Lynch to include separate containers with associated friction pick mechanisms as taught by Drescher. One of ordinary skill in the art at the time of the invention would have been motivated to expand the terminal of Graef in view of Lynch in this way since since removable canisters allows for easier removal by authorized personnel (see at least col. 11, ll. 40-46 of Drescher).

Re Claim 10: Graef in view of Lynch discloses the claimed terminal and Graef further discloses wherein the friction pick units share a common media exit path which is within the media module and leads to the media dispense path (see at least See Fig 1, process 54 across common path 56 to secondary transport 60; Column 7 lines 53-67).

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Graef in view of Lynch et al (hereinafter Lynch, US 6,029,971) and Drescher (US 6,131,809).

Re Claim 11: Graef discloses a self-service terminal comprising:

- Means defining a media dispense path (see at least Fig 1, See arrows related to Refs 54, 56, 60 and 62)
- A number of media modules (see at least Fig 1; 44, 46, 48, and 50), and transferring the picked media to the media dispense path (see at least Fig 1, Ref 54, 56)

Graef does not explicitly disclose wherein the media dispensing modules are removable, however Lynch discloses a self service terminal wherein the modules are removable (see at least Column 2, lines 59-62). It would have been obvious to anyone of ordinary skill in the art at the time of invention to include the teachings of Lynch to the disclosure of Graef so that said modules can be taken from the machine to either be refilled or taken to a remote location for deposit or reconciliation with records related to transactions at the machine.

Drescher teaches at least one media module including a plurality of media containers and a friction pick mechanism operatively associated with each media container for picking media from the media container (see at least Fig. 58; Column 28, lines 1-22). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the terminal of Graef in view of Lynch to include separate containers with associated friction pick mechanisms as taught by Drescher. One of ordinary skill in the art at the time of the invention would have been motivated to expand the terminal of Graef in view of Lynch in this way since removable canisters allows for easier removal by authorized personnel (see at least col. 11, ll. 40-46 of Drescher).

Response to Arguments

Applicant's arguments filed 6 August 2007 have been fully considered but they are not persuasive. It is respectfully pointed out that although the specified citations within Drescher, Graef, and Lynch are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures may apply.

Art Unit: 3692

With regard to claims 12 and 14 as being anticipated by Drescher, Applicants argue Drescher does not disclose separate media containers within a media module. The Examiner respectfully disagrees for at least the following reasons. Applicants noted Drescher shows separate storage areas within a canister, it is respectfully pointed out that Applicants specification however does not provide an explicit definitions for "media containers" and "media module". Furthermore, in paragraph [0004] of Applicants published application (US 20020198838), it is stated that a conventional ATM is usually provided with two, three or four media modules, or cassettes. Thus the separate storage areas within a canister as taught by Drescher do not function any differently than the "media containers" and "media module" recited by the claims. Therefore, the Examiner maintains that Drescher teaches the claimed "media containers" and "media module".

With regard to claims 12 and 14 as being anticipated by Drescher, Applicants further argue that Drescher does not disclose a separate pick mechanism for each media container. The Examiner respectfully disagrees for at least the following reasons. The Office Action dated 4 May 2007 pointed Applicants to col. 29, ll. 15-20 and col. 27 l. 21 through col. 29, line 59 with respect to this recitation, please refer to page 3 of the previous Office Action. It is respectfully pointed out that Drescher discloses at col. 25, ll. 17-23 that the storage of documents is described with reference to Figs. 47-53 and that for purposes of illustration, storage of a document in storage area (102) as shown in Fig. 35 will be discussed. It is respectfully pointed out that at least Fig. 58 shows a friction pick associated with each media container. In view of the disclosure and Figures of Drescher the Examiner maintains that Drescher discloses "a friction pick mechanism associated with each media container within the media module for picking media from the media container", as recited by claim 12, and "wherein each of the media containers within the media module includes a friction pick mechanism for picking media", as recited by claim 14. Further, it is respectfully pointed out that the claims as written do not require the friction pick be physically or rigidly attached to each individual media container. In view of the above comments, the Examiner maintains the rejection of claims 12 and 14 as being anticipated by Drescher.

With regard to claims 1-10 and 13 as being obvious in view of the combination of Graef and Lynch, Applicants argue that the previous Office Action applies hindsight with respect to teaching a

Art Unit: 3692

vacuum pick and a friction pick in the same self service machine. The Examiner respectfully disagrees for at least the following reasons. In response to applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Further, Applicants are respectfully pointed to col. 13, l. 64 through col. 14, l. 7 of Graef. In particular, Graef discloses that the Graef picking mechanism may be readily retrofit to an existing automated banking machine. Moreover, this allows for replacing an existing picking member which does not include the features of the Graef picking mechanism and install the Graef picking mechanism in the existing picking mechanism's place. Graef therefore, teaches two different types of picking mechanisms within one unit. The Examiner therefore maintains that it would have been obvious to include both a vacuum and friction pick in one system since Graef teaches two different types of picking mechanisms can be house within the same unit. In view of the above comments, the rejection of claims 1-10 and 13 as being obvious over Graef in view of Lynch remains.

With respect to claims 2 and 7, Applicants argue Lynch does not teach modules that are removable and interchangeable. The Examiner respectfully disagrees for at least the following reasons. As mentioned above, in paragraph [0004] of Applicants published application (US 20020198838), it is stated that a conventional ATM is usually provided with two, three or four media modules, or cassettes. Moreover, Lynch a currency cases containing a stack of currency notes is removably mounted. In addition it would be expected that the removable containers of Lynch would also be interchangeable since the containers are used for currency and currency has the same dimensions (i.e. \$10, \$20, etc.). In view of this the Examiner maintains Lynch teaches removable and interchangeable.

With respect to claims 3 and 8, Applicants argues that Graef does not teach a friction pick mechanism contained within the friction pick module. The Examiner respectfully disagrees for at least the following reasons. The claims as currently written do not contain any specific relational and/or physical

Art Unit: 3692

association between elements, i.e. is the friction pick partially, fully, etc. within the friction pick module. In view of the above, the Examiner maintains Graef teaches these limitations.

With respect to claims 5 and 10, Applicants argue Graef does not teach a media module as recited and therefore does not teach the friction pick units share a common media path which is within the media module and leads to a media dispense path. The Examiner disagrees for at least the following reasons. As presented above, Graef teaches the claimed media module and therefore teaches the friction pick units share a common media path which is within the media module and leads to a media dispense path. Moreover, the claims as currently written do not require any specific relational and/or physical association between elements. In view of the above, the Examiner maintains Graef teaches these limitations.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah M. Monfeldt whose telephone number is (571)270-1833. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm (EST) ALT Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571)272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3692

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sarah M. Monfeldt
Patent Examiner, AU 3692
571-270-1833

A handwritten signature in black ink, appearing to read 'K. Abdi', with a long horizontal flourish extending to the right.

Kambiz Abdi
AU 3692, SPE